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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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10/576,299

04/19/2006

Motoshige Sumino

WKP-003

4456

20374 7590 07/21/2008

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EXAMINER

NWAONICHA, CHUKWUMA O

ART UNIT

PAPER NUMBER

1621

MAIL DATE

DELIVERY MODE

07/21/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--|--------------------------------------|--|
| Office Action Summary | Application No. 10/576,299 | Applicant(s) SUMINO ET AL. | |
| | Examiner CHUKWUMA O. NWAONICHA | Art Unit 1621 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 April 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Current Status

1. This action is responsive to Applicants' amendment of 24 April 2008.
2. Receipt and entry of Applicants' amendment is acknowledged.
3. Claims 1-8 and 10 are pending in the application.
4. This action is responsive to Applicants' amendment of 17 March 2008.
5. Receipt and entry of Applicants' amendment is acknowledged.

The 103 rejection of claims 1-8 and 10 under 35 U.S.C. 103(a) as being unpatentable over Oono et al., {US 6,723,483} in view of Osawa et al., {US 5,824,824} is maintained for the reason stated in the previous Office Action dated 12/04/2007.

Applicants' arguments filed 17 March 2008 have been fully considered but they are not persuasive. Applicants argue that the method of the present invention shows unexpected excellent effects with the use a larger amount of the activator than has been conventionally used. Applicants further argue that in particular, the use of 4.5 to 7.5 eq. of the activator can obtain a desired sulfonium salt efficiently in a high purity without byproducts.

Applicants' arguments have been consider in light of the prior art references cited and the Examiner notes that there is no significant improvement in terms of unexpected result provided by the current process. The difference in terms of product yield between the current application and the process of the prior art references cited is not big enough to warrant unexpected result. Many prior art references teach Applicants claimed process with low amount of the activator with high product yield. For example,

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US 6,924,323 teach a method for producing a triarylsulfonium salt by reacting a diaryl sulfoxide and an aryl Grignard reagent (RMgX) in the presence of an activator at a level of 2.5 mole parts relative to the diaryl sulfoxide followed by the reaction with a strong acid to give a high yield of the product, see example 2 of US 6,924,323. It should be noted that modification of a process is a well-known chemical practice to optimize the process efficiency of the system and does not constitute a patentable distinction.

Additionally, merely modifying the process conditions such as concentration is not a patentable modification absent a showing of criticality. In re Aller, 220 F.2d 454, 105 U. S. P. Q. 233 (C. C. P. A. 1955). Therefore, the process claimed is taught by the prior art references cited and the instantly claimed invention would therefore have been obvious to one of ordinary skill in the art wishing to modify the prior arts' process.

Objection of the Specification

The Specification is objected because TABLE 6 on page 15 of the Patent Application Publication US 2007/0083060 is written in Japanese language. Correction is required.

THIS ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chukwuma O. Nwaonicha whose telephone number is 571-272-2908. The examiner can normally be reached on Monday thru Friday, 8:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne (Bonnie) Eyler can be reached on 571-272-0871. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Chukwuma O. Nwaonicha/
Examiner, Art Unit 1621

/Jafar Parsa/
Primary Examiner, Art Unit 1621

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